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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|----------------------|------------------|
| 09/891,486 | 06/25/2001 | Hideo Yokota | 8305-210US (NP102-1) | 9376 |

570 7590 03/17/2003

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2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103-7013

EXAMINER

MCAVOY, ELLEN M

ART UNIT

PAPER NUMBER

1764

DATE MAILED: 03/17/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|------------------------------|------------------------|---------------------|
| | 09/891,486 | YOKOTA ET AL. |
| Examiner | Art Unit | |
| Ellen M McAvoy | 1764 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 10 March 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-7, 10-11, 13-15, and 17-24 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-7, 10-11, 13-15 and 17-24 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. ____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). ____ .
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ . 6) Other: ____ .

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on 10 March 2003 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 10-11, 13-15, 17-19 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zielinski (5,756,430) alone or in combination with Ott (6,085,782).

As set forth in the previous office action, Zielinski discloses a mist oil lubricant which distributes fine droplets of oil compositions in aerosol form to the areas of various machine elements to be lubricated. The compositions comprise (A) 90-95 percent by weight of an ester oil having a viscosity of 10-150 cSt at 40°C, (B) 3-5 percent of an additive selected from rust inhibitors, corrosion inhibitors, anti-wear agents, anti-foam agents, antioxidants such as phenolic antioxidants, demulsifiers, extreme pressure agents and mixtures thereof, and (C) 1-5 percent of a polyisobutylene stray mist suppressant. See the claims. Suitable ester oils are set forth in

column 2, lines 23-41, and include straight and branched chain alkyl esters of aromatic or aliphatic polycarboxylic acids. The examiner is of the position that the mist oil lubricant of Zielinski clearly meets the limitations of the cutting and grinding oil composition of independent claim 1 which has been amended to include other components. The claim reads on a composition which may comprise 100 percent of an ester having a kinematic viscosity of 1 to 100 mm²/s at 40°C which is clearly taught by Zielinski. The examiner is of the position that the intended use language “a cutting or grinding oil composition for a minimal quantity lubrication system” carries little if any weight in the composition claims. As set forth in MPEP 2111.02, intended use recitations and other functional language in the preamble cannot be entirely disregarded. However, the intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. Thus, the intended use may further limit the claim if it does more than merely state the purpose or intended use. Here, the preamble merely states an intended use which fails to further limit the composition.

As previously set forth, Ott is added only to teach that “minimal quality lubrication” is a term known in the lubricant art for tool working to signify that only very small quantities of lubricant are used. Ott teaches that a suitable method includes supplying a constantly uniform oil mist in steady and even manner to the working area of the tool. See column 1, lines 10-67. Ott teaches that oil compositions can be supplied to workpieces in an amount of 20 ml per hour. See column 2, top. The examiner maintains of the position that the mist oil lubricant of Zielinski can be applied to a workpiece in such a manner if so desired.

Claim Rejections - 35 USC § 103

Claims 1, 7, 10, 11 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koyama et al (5,171,903) alone, or in combination with Ott (6,085,782).

As previously set forth, Koyama et al [“Koyama”] disclose a lubricating oil composition for plastic working, metal working, or for cutting and grinding which comprises (i) a linear olefin having 6 to 40 carbon atoms as a base oil, (ii) at least one member of compounds selected from the group consisting of alcohol, glycol, polyalkylene glycol, and a derivative of polyalkylene glycol and fatty acid, and (iii) at least one of phenolic compounds and amine compounds. See column 2, lines 3-54. Component (ii) includes fatty acid esters of polyethylene glycol which may be added to the composition in an amount of 0.05 to 50 weight % of the entire composition. See column 16, lines 25-51. The examiner maintains the position that the ester component of Koyama meets the limitations of the ester component of the claims. The composition of the prior art also includes alkyl-substituted phenols as component (iii) in an amount of 0.1 to 2.0 weight % based on the entire composition. See column 16, line 52, to column 17, line 50. This meets the limitation of the oiliness component of the claims when it comprises (D), compounds represented by formula (1) set forth in dependent claim 10. The composition of Koyama can also be blended with a suitable quantity of well-known oiliness agents, extreme-pressure agents, rust inhibitors, corrosion inhibitors, and the like. See column 17, line 52 to column 18, line 2. Thus, the examiner maintains the position that the composition of Koyama meets the limitations of the cutting and grinding oil composition of the claims. Ott is added to teach that “minimal quality lubrication” is a term known in the lubricant art for tool

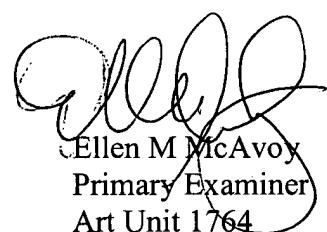
working. See column 1, lines 10-67. Ott teaches that oil compositions can be supplied to workpieces in an amount of 20 ml per hour. See column 2, top. The examiner is of the position that the cutting and grinding oil composition of Koyama can be applied to a workpiece in such a manner if so desired.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (703) 308-2510. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Calderola can be reached on (703) 308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Ellen M McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
March 17, 2003